



PATENT

Attorney Docket No.: A-67229-6/RFT/RMS/RMK
Attorney File No. 463077-00005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

DAHIYAT et al.

Serial No. 09/782,004

Filed: February 12, 2001

For: *Protein Design Automation for
Protein Libraries*

Examiner: Borin, Michael L.

Group Art Unit: 1631

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Mailed: June 29, 2006

Signed: *Victoria Linne Poulsen*
Victoria Linne Poulsen

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Box Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In satisfaction of the duty of disclosure under 37 C.F.R. § 1.56, and in accordance with the provisions of 37 C.F.R. §§ 1.97 and 1.98, Applicants wish to draw the attention of the U.S. Patent and Trademark Office to the references cited on the accompanying substitute for form PTO-1449. Copies of the references are enclosed.

None of the foregoing references are believed to disclose the invention as claimed. Nothing herein shall constitute an admission concerning the contents of any of the cited references, nor shall the inclusion of a reference herein be considered an admission that the reference constitutes prior art against the invention claimed in the above-identified application. Submission of the present document shall not be construed as an admission that a search has been made or that better art does not exist.

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Further, in accordance with the provision of 37 C.F.R. §§ 1.97(c) and 1.97(e)(1), the undersigned certifies that references A1, B3, C3 and C4 listed on the enclosed form SB/08A Substitute for PTO-1449 were cited in the International Search Report dated March 31, 2006, for a counterpart European Patent Application, EP 04015169. A copy of the International Search Report for the counterpart EP application is enclosed herewith.

Further, in accordance with the provision of 37 C.F.R. §§ 1.97(c) and 1.97(e)(1), the undersigned certifies that references A1 and B4, listed on the enclosed form SB/08A Substitute for PTO-1449 were cited in the International Search Report dated March 14, 2006, for a counterpart European Patent Application, EP 04016539. A copy of the International Search Report for the counterpart EP application is enclosed herewith.

Further, in accordance with the provision of 37 C.F.R. §§ 1.97(c) and 1.97(e)(1), the undersigned certifies that references A1 listed on the enclosed form SB/08A Substitute for PTO-1449 were cited in the International Search Report dated February 28, 2006, for a counterpart European Patent Application, EP 04016943. A copy of the International Search Report for the counterpart EP application is enclosed herewith.

Further, in accordance with the provision of 37 C.F.R. §§ 1.97(c) and 1.97(e)(1), the undersigned certifies that references A1 and A2 listed on the enclosed form SB/08A Substitute for PTO-1449 were cited in the International Search Report dated February 27, 2006, for a counterpart European Patent Application, EP 04015782. A copy of the International Search Report for the counterpart EP application is enclosed herewith.

Further, in accordance with the provision of 37 C.F.R. §§ 1.97(c) and 1.97(e)(1), the undersigned certifies that references A2, B3, B5, and B6, listed on the enclosed form SB/08A Substitute for PTO-1449 were cited in the International Search Report dated February 17, 2006, for a counterpart European Patent Application, EP 02763433. A copy of the International Search Report for the counterpart EP application is enclosed herewith.

Further, in accordance with the provision of 37 C.F.R. §§ 1.97(c) and 1.97(e)(1), the undersigned certifies that references B1, B2, B7, B8, B9, C1, and C2, , listed on the enclosed form SB/08A Substitute for PTO-1449 were cited in the International Search Report dated February 17, 2006, for a counterpart

Serial No. 09/782,004
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European Patent Application, EP 04015112. A copy of the International Search Report for the counterpart EP application is enclosed herewith.

Further, in satisfaction of the duty of disclosure under 37 C.F.R. § 1.56, and as required by M.P.E.P. § 2001.06(b), Applicant notes that the present application is related to the following pending patent applications:

1. U.S.S.N. 09/927,790, filed August 10, 2001;
2. U.S.S.N. 10/101,499, filed March 18, 2002;
3. U.S.S.N. 10/218,102, filed August 12, 2002;
4. U.S.S.N. 10/666,311, filed September 18, 2003; and
5. U.S.S.N. 10/665,307; filed September 18, 2003

Pursuant to 37 C.F.R. § 1.97(c), payment by check is enclosed in the amount of \$180.00 as set forth in 37 C.F.R. § 1.17(p). Although no further fee is believed to be due, if this belief is in error the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-2319 (Our Order No. 463077-00005 (A-67229-6 / 463077-0005)).

Please direct any calls in connection with this application to the undersigned at (415) 781-1989.

Respectfully submitted,
DORSEY & WHITNEY LLP

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Filed under 37 C.F.R. § 1.34(a)



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Substitute PTO/SB/08A (07-05)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Substitute for form 1449/PTO
(Modified)

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(use as many sheets as necessary)

Complete if Known

| | |
|------------------------|-------------------------|
| Application Number | 09/782,004 |
| Filing Date | February 12, 2001 |
| First Named Inventor | Dahiyat et al. |
| Art Unit | 1631 |
| Examiner Name | Borin, Michael |
| Attorney Docket Number | Docket 67299-6 463077-5 |

Sheet **1** of **2**

U.S. PATENT DOCUMENTS

| Examiner Initials* | Cite No. ¹ | Document Number Number-Kind Code ² (if known) | Publication Date MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear |
|--------------------|-----------------------|---|--------------------------------|---|--|
| | A1 | US-2002-0090648 | 07-11-2002 | Dahiyat et al. | |
| | A2 | US-2003-0049654 | 03-13-2003 | Dahiyat et al. | |
| | A3 | US-2004-0043429 A1 | 03-04-2004 | Dahiyat et al. | |
| | A4 | US-2004-0043430 A1 | 03-04-2004 | Dahiyat et al. | |
| | A5 ↑ | US-5436850 | 07-25-1995 | Eisenberg et al. | |
| | A6 | US-6269312 | 07-31-2001 | Mayo et al. | |

FOREIGN PATENT DOCUMENTS

| Examiner Initials* | Cite No. ¹ | Foreign Patent Document Country Code ² Number ³ Kind Code ⁵ (if known) | Publication Date MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear | T ⁶ |
|--------------------|-----------------------|---|--------------------------------|--|---|----------------|
| | B1 ↑ | EP 0549107 A | 06-30-1993 | Syntex Inc. | | |
| | B2 ↑ | WO 00/40715 A | 07-13-2000 | Trustees of Boston University | | |
| | B3 ↑ | WO 01/37147 A | 05-25-2001 | Algonomics NV | | |
| | B4 ↑ | WO 01/39098 A | 05-31-2001 | Yissum Research Development Company of the Hebrew | | |
| | B5 ↑ | WO 01/61344 A | 08-23-2001 | California Institute of Technology | | |
| | B6 ↑ | WO 03/006154 A | 01-23-2003 | Xencor, Inc. | | |
| | B7 ↑ | WO 94/16090 A | 07-21-2004 | Molecular Tool, Inc. | | |
| | B8 ↑ | WO 98/05765 A | 02-12-1998 | Novo Nordisk A/S | | |
| | B9 ↑ | WO 98/32845 A | 07-30-1998 | Bionvent International AB | | |

NON PATENT LITERATURE DOCUMENTS

| Examiner Initials* | Cite No. ¹ | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published. | T ⁶ |
|--------------------|-----------------------|---|----------------|
| | C1 ↑ | Cojee et al. "Seamless gene engineering using RNA- and DNA- overhang cloning" <i>Nature Biotechnology</i> , vol. 18, (2000) pps. 1087-0156 | |
| | C2 ↑ | Gal J. et al. "Directional Cloning of Native PCR Products with Performed Sticky Ends" <i>Mol. Gen. Genet.</i> Vol. 260, no. 6, (1999), pps. 569-573 | |
| | C3 | Koehl P. et al., "De novo protein design I. in search of stability and specificity" <i>J. Mol. Biol.</i> , vol. 293, no. 5, (1999) pps. 1161-1181 | |
| | C4 ↑ | Wernisch L. et al. "Automatic protein design with all atom force-fields by exact and heuristic optimization" <i>J. Mol. Biol.</i> Vol. 301, no. 3, (2000), pps. 713-736 | |

Gen.

| | |
|--------------------|-----------------|
| Examiner Signature | Date Considered |
|--------------------|-----------------|

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹ Applicant's unique citation designation number (optional). ² See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Applicant is to place a check mark here if English Language Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the complete application form to the USPTO. Time will vary depending on the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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